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SCIENTIFIC-ATLANTA, INC.
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| EXAMINER |
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BELIVEAU, SCOTT E

| ART UNIT | PAPER NUMBER |
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2614

DATE MAILED: 12/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/590,434

Applicant(s)

JERDING ET AL.

Examiner

Scott Beliveau

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 43-71 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 43-71 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: ____

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DETAILED ACTION

Election/Restrictions

1. As previously noted in Paper No. 12, claims 1-5, 16-21, and 23-42 were withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 11.

Priority

2. With respect to the applicant's request for receiving benefit to an earlier filing date under 35 U.S.C. 119(e), upon further consultation it was determined that the provisional application in its entirety must be considered with respect to the claim for priority and as such the previous Notice of Non-Responsive Amendment, Paper No. 12 was premature.
3. However, upon further consideration of the provisional application in its entirety, it is the examiner's opinion that the applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119(e).

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application); the disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994). The only potential reference to the claimed material that the examiner found after further review of the provisional application is a

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suggestion that the embodiment is operable to display of movie trailers or free previews (Page 4). However, it is the examiner's opinion that the brief reference to the display of such information is insufficient support to meet the particularly claimed subject matter as the provisional application fails to suggest any particular "method" involving particular steps involved in the display of such information as required by claims 43, 51, 57, 66, and their associated dependent claims. For example, it is unclear that the user is necessarily provided with selectable options so as to choose to display "promotional media" and to subsequently provide the user with a "media presentation" corresponding to the request as required by claim 43 or to provide a "promotional media presentation" during the user initiated pausing of a "media presentation" in progress which is subsequently "resumed" as recited in claim 51. Claims 57 and 66 are apparatus claims corresponding to claims 43 and 51 respectively. Accordingly, for the purposes of evaluation of prior art, the application filing date shall be the filing date of the instant application or 09 June 2000.

As there does not appear to be support for the claimed subject matter of the instant application in the provisional application, the examiner's prior remarks pertaining to public usage and/or prior art status of documents previously referenced are rendered moot as the provisional application does not appear to correspond to the claimed subject matter.

However, it is noted that although the examiner has reviewed the provisional application for support under 35 U.S.C. 112 given the size of the provisional application and lack of a clear correspondence between it and the instant application, information within the provisional application may have been overlooked. If the applicant continues to feel that the examiner has overlooked such support/subject matter, it is requested that the applicant reference this

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subject matter by page number in response to this Office Action so that the examiner may quickly locate and evaluate the applicant's remarks in view of the provisional application.

Drawings

4. The drawings were received on 14 October 2003. These drawings are approved with respect to enclosed Figures 4C, 4D, 4H, 4I, and 7.
5. The drawings are objected to because Figure 19A contains two references to element "270". A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Response to Arguments

6. Applicant's arguments with respect to claims 6-15 and 22 have been considered but are moot in view of the new ground(s) of rejection necessitated as applicant has cancelled all previously presented claims.
7. With respect to the applicant's traversal of the OFFICIAL NOTICE presented in the prior action, no further evidence is being provided in conjunction with the examiner's assertion that it is known in the art for "promotional channels" to be associated with a "particular theme or genre" as such limitations are not present in the newly presented claims.
8. With respect to the applicant's traversal of the OFFICIAL NOTICE presented in the prior action with respect to the examiner's assertion that it is notoriously well known for video programming such as movies to contain commercials or "sequences of trailers of other media

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in some way associated with the movie”, the examiner notes that evidence of such may be found in the previously cited Candelore reference (Col 10, Lines 54-62) with respect to the display of commercials in conjunction with VOD presentations. Alternatively, the usage of trailers in conjunction with interactive guides is described in the previously cited Knudson et al. reference (Col 2, Lines 20-31). Further evidence of the existence of trailers prior to media presentations such as movies is also described in the “A Brief History of the Trailer” article, which discloses that movie trailers have been known and utilized in the art since 1912.

Claim Rejections - 35 USC § 112

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claims 45 and 59 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for “disabling trick-mode functionality for the first promotional media presentation”, does not reasonably provide enablement for “disabling trick-mode functionality for the first promotional media presentation”. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims. In particular, support for the claimed method as recited in independent claims 43 and 57 appears in relationship to Figure 8B wherein a user may select a title, select the info button [240] to initiate a preview/trailer, and to subsequently order the movie subsequent to the preview (Page 14, Line 35 – Page 15, Line 14; Page 20, Lines 30-33). The specification explicitly

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discloses that “VOD stream control mechanisms (i.e., fast-forward, rewind, pause are typically disabled during the preview” (Page 20, Lines 30-31). Accordingly, the examiner is unclear as to where support is found for the “enabling [of] trick-mode functionality” during the presentation of the preview/trailer.

11. Claims 51-56 and 66-71 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, claims 51 and 66 require for the display of a media presentation and subsequent to a “first user input” the presentation is “suspended” and a “promotion media presentation” is displayed. As to support for such, it is the examiner’s best guess that support for this subject matter is found in relation to the screen-saver functionality of previously non-elected Invention IV. If such is the case, it is arguable one may broadly construe that responsive a first user input that stops the presentation that a “promotional media presentation” may be provided; however, the “presentation of the media presentation” is not resumed as required by the claims (Page 28, Line 31 – Page 29, Line 2; Page 29, Line 36 – Page 30 , Line 9).

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. Claims 43, 44, 47, 49, 57, 58, 61, 63, and 64 are rejected under 35 U.S.C. 102(b) as being anticipated by Billock et al. (US Pat No. 6,526,577).

In consideration of claims 43 and 57, the Billock et al. reference discloses a method implemented via a "DHCT" [14] comprising a "memory" and a "processor" (Col 8, Line 9 – Col 9, Line 11) wherein a viewer is "provided a selectable option identifying a promotional media presentation" as illustrated in Figure 6. The "DHCT" [14] is "provided" with the "promotional media presentation" upon "receiving a first user input" [68] via a "video-on-demand session" (Col 2, Lines 43-47) as illustrated in Figure 7. Subsequently, the embodiment may "provide the media presentation responsive to the DHCT receiving a second user input requesting a media presentation corresponding to the promotional media presentation" [62] (Col 17, Line 15 – Col 18, Line 19).

In consideration of claims 51 and 66, as aforementioned the Billock et al. reference discloses a method implemented via a "DHCT" [14] comprising a "memory" and a "processor" (Col 8, Line 9 – Col 9, Line 11). The claim is not limiting with respect to the nature of the "media presentation" and the "promotional media presentation" such that they necessarily comprise any particular form or that they are necessarily different from one another. As illustrated in conjunction with Figure 6, the embodiment "provides a media presentation" [42] or image pertaining to a particular title. Upon receipt of a "first user input" [68], the "media presentation" [42] is "suspended" and a "promotional media presentation" [42] is "provided". Subsequently, the "media presentation" [42] may be "resumed . . . responsive to a second user input" [66].

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Claims 44, 58, and 64 are rejected wherein the “promotional media presentation” comprises a “portion of the media presentation” in the form of a “preview of the media presentation” (Figure 7; Col 2, Lines 53-56; Col 11, Lines 32-42).

Claims 47, 53, 61, and 68 are rejected wherein the “media presentation” is provided via a “VOD session” (Col 2, Lines 43-47).

Claims 49, 54, 63 and 69 are rejected wherein the “promotional media presentation” comprises a “trailer of the media presentation” (Col 11, Lines 32-42) wherein a “trailer” as defined in the Merriam Webster’s Collegiate Dictionary 10th Edition is a “preview”.

Claims 52, 55, 67, and 70 are rejected wherein the “promotional media presentation” is provided via a “VOD session” (Col 2, Lines 43-47).

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the

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time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

16. Claims 48, 50, 56, 62, 65, and 71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Billock et al. (US Pat No. 5,619,249).

In consideration of claims 48 and 62, the Billock et al. reference does not explicitly disclose nor preclude “providing a second promotional media presentation responsive to receiving the second user input” such that a user requesting a “media presentation” or movie is initially presented with a “second promotional media presentation” such as a trailer for other movies. It would have been obvious to one having ordinary skill in the art at the time the invention was made to further display a “second promotional media presentation” such as a movie trailer at the start of a requested movie presentation since it was known in the art that movie presentations are typically preceded with trailers. Such a modification may further be advantageous in so far as it would inform the user of other programs of interest that may be available and/or provide the operator with an additional source of advertising revenue as a marketing tool.

In consideration of claims 50, 56, 65, and 71, the Billock et al. reference discloses that the “media presentation” is a video program such as one that one might rent from a video store (Col 2, Lines 14-21), however, it does not explicitly disclose nor preclude that the video program is necessarily a “movie” or a still image from a “movie”. It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize video programs such as movies since it was known in the art that movies are a form of video program commonly rented from a video store.

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17. Claims 45 and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Billock et al. (US Pat No. 5,619,249), in view of White et al. (US Pat No. 6,628,302).

In consideration of claims 45 and 59, it is unclear from the Billock et al. reference as to whether or not the embodiment is operable to support "trick-mode functionality" however the use of such is well known in the art. For example, the White et al. reference explicitly provides evidence of "trick-mode functionality" in conjunction with VOD programming (Figure 5). Accordingly, it would have been obvious to one having ordinary skill in the art at the time of the invention modify the Billock et al. reference to provide "trick-mode functionality" for the purpose of advantageously providing the user with a means so as to control the presentation of media. Furthermore, it would have been obvious to one having ordinary skill in the art at the time of the invention to "enable trick-mode functionality for the first promotional media presentation" for the purposes of advantageously providing the user with a means so as to similarly control the playback of the "promotional media". For example, it may be desirable to provide a user with the ability to replay a particular portion or segment of interest of a preview/trailer without having to re-watch the entire segment or to allow the user to pause the preview/trailer such that they can continue the presentation should they momentarily leave the room.

18. Claims 46 and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Billock et al. (US Pat No. 5,619,249), in view of Nishio (US Pat No. 6,070,186).

With respect to claims 45 and 60, it is unclear from the Billock et al. reference as to whether or not the embodiment is operable to support "trick-mode functionality". The Nishio reference discloses a VOD system that further supports "trick-mode functionality"

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wherein such functionality may be “disabled” (Col 13, Lines 31-48) during “promotional media presentations” (Col 12, Line 65 – Col 13, Line 3). Accordingly, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the Billock et al. reference to further support VOD “trick-mode functionality” as disclosed by Nishio for the purpose of advantageously requiring subscribers to watch commercial video programs associated with the requested media (Nishio: Col 2, Lines 21-36).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure as follows. Applicant is reminded that in amending in response to a rejection of claims, the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objections made.

- The Hayashi (US Pat No. 5,995,134) reference discloses a method and apparatus for presenting a promotional screen saver to a user of a VOD environment.
- The Dunn et al. (US Pat No. 5,861,906) reference discloses a VOD application that facilitates the ability to browse VOD previews/trailers and to order VOD programming.
- The “Brief History of the Trailer” article generally describes the history and development of movie trailers over the past 80 years.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Beliveau whose telephone number is 703-305-4907. The examiner can normally be reached on Monday-Friday from 9:00 a.m. - 6:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 703-305-4795. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-HELP.

SEB
December 13, 2003


JOHN MILLER
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